

Notice of Allowability

Application No.

09/903,771

Examiner

Kathleen M Kerr

Applicant(s)

MOECKEL ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/20/04.
2. ☒ The allowed claim(s) is/are 3,13,17,19,37,38 and 52-54.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____



Kathleen M Kerr
Primary Examiner
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DETAILED ACTION

Application Status

1. In response to the previous Office action, a non-final rejection (mailed on June 18, 2004), Applicants filed a response and amendment received on September 20, 2004. Said amendment cancelled Claims 1, 4, 10-12, 14-16, 18, and 40-49, amended Claims 17, 19, and 37, and added two new claims. Since “new” claims 50-51 do not look like previously filed claims 50-51, the Examiner must assume that Claims 50-51 have also been cancelled and Claims 50-51 are new claims to be renumbered as Claims 52-53 for prosecution herein. Thus, Claims 3, 13, 17, 19, 37, 38, 52, and 53 are pending in the instant Office action and will be examined herein.

Priority

2. As previously noted, the instant application is granted the benefit of priority for the foreign application 10039043.9 filed in Germany on August 10, 2000; a translation of said document has been filed.

Withdrawn - Claim Objections

3. Previous objection to Claims 16, 17, 43, 47, and 51 for capitalizing “Coryneform” is withdrawn by virtue of Applicant’s amendment.

Withdrawn - Claim Rejections - 35 U.S.C. § 112

4. Previous rejection of Claims 10-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for the phrase “**consisting of at least** 30 consecutive nucleotides” (emphasis added) is withdrawn by virtue of Applicant’s cancellation of said claims.

5. Previous rejection of Claims 18-19 under 35 U.S.C. § 112, second paragraph, as being indefinite for the species *B. lactofermentum* and *B. divaricatum*, which are synonyms of *C. glutamicum*, is withdrawn by virtue of Applicant's cancellation of these members of the Markush group.
6. Previous rejection of Claims 40-51 under 35 U.S.C. § 112, first paragraph, new matter, is withdrawn by virtue of Applicant's cancellation of said claims.
7. Previous rejection of Claim 10 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicant's cancellation of said claims.
8. Previous rejection of Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's cancellation of said claims.
9. Previous rejection of Claims 40-51 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's cancellation of said claims.

Withdrawn - Claim Rejections - 35 U.S.C. § 102

10. Previous rejection of Claims 40-51 under 35 U.S.C. § 102(e) as being anticipated by USPAP 2002/0197605 (Nakagawa *et al.*) is withdrawn by virtue of Applicant's cancellation of said claims.
11. Previous rejection of Claims 40-51 under 35 U.S.C. § 102(a) as being anticipated by EP 1108790 (Nakagawa *et al.*) is withdrawn by virtue of Applicant's cancellation of said claims.

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12. Previous rejection of Claims 40-43 under 35 U.S.C. § 102(a) as being anticipated by WO 01/00842 (Pompejus *et al.*) is withdrawn by virtue of Applicant's cancellation of said claims.

EXAMINER'S AMENDMENT

13. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Daniel Pereira on November 22, 2004.

Amendments to the Claims

14. The claims have been amended as follows:

a) Rewrite Claim 17 as follows:

---17. The host cell of Claim 54, which is a coryneform bacterium.---

b) Rewrite Claim 19 as follows:

---19. The host cell of Claim 17, wherein said host cell is selected from the group consisting of *Corynebacterium glutamicum*, *Corynebacterium acetoglutamicum*, *Corynebacterium acetoacidophilum*, *Corynebacterium melassecola*, *Corynebacterium thermoaminogenes*, and *Brevibacterium flavum*.---

